

Restriction Requirement under 35 U.S.C. §121

The Examiner has required restriction to one of the following inventions under 35 U.S.C. §121:

- I. Claims 1-19 and 39, drawn to a drilling fluid, classified in Class 507, subclass 118.
- II. Claims 20-38 and 40-43, drawn to a method of inhibiting borehole wall invasion, classified in Class 166, subclass 285.

The inventions are alleged to be distinct, each from the other because of the following reasons:

Inventions I and II are allegedly related as a product and a process of use. The inventions are allegedly distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product, or (2) the product as claimed can be used in a materially different process of using that product. In the instant case, the Examiner contends that the product may be used as a sealing composition in other than a wellbore.

Because these inventions are allegedly distinct for the reasons given above and have acquired a supposed separate status in the art as shown by their different classification, the restriction for examination purposes as indicated is contended to be proper.

The Applicants hereby elect with traverse the claims **20-38 and 40-43 of Group II**, drawn to a method of inhibiting borehole wall invasion.

Applicants respectfully traverse the restriction requirement as not complying with the statutory law in this area. Specifically, the Examiner has made no showing that the two sets of claims are "independent *and* distinct." The law states, in 37 CFR §1.142, that:

(a) If two or more *independent and* distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction ... (Emphasis added.)

While there is some difference in the way this statute is interpreted in the MPEP, it should be noted that:

"The MPEP ... is entitled to notice so far as it is an official interpretation of the statutes or regulations with which it is not in conflict." See *Litton Systems, Inc. v. Whirlpool Corp.*, 221 U.S.P.Q. 97, 107 (Fed. Cir. 1984).

As the MPEP is in *direct* conflict with the law on this point, it is not entitled to *any* weight on the matter. The Examiner only argues distinctness in the rejection; there is no assertion or showing of *independence*.

The alleged distinct inventions herein have not been shown to be *independent* as required by 37 CFR §1.142. In fact, independent claim 1 defines water-based drilling fluid that if used in a method contemplated by the claims, the method would be that of independent claim 20, *e.g.* That is, a method such as that of independent claim 20 would necessarily use the water-based drilling fluid of independent claim 1, indeed there is much common language between these two claims and the fluid is identical. The Examiner is further invited to compare independent method claim 38 with independent composition claim 19 where again the identical fluid is recited between these two claims. Thus, these claims are not independent from one another either. Other close similarities between the language of method claims 20-38 and 40-43 and the language of composition claims 1-19 and 39 may be found. Thus, it is respectfully submitted that these two groups of claims are *not* independent from each other, but rather are intimately linked.

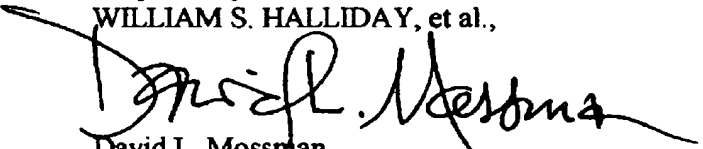
Further, the Examiner's argument that the drilling fluid of Group I as claimed can be used to practice another and materially different process, such a sealing composition in *other than* a wellbore is not supported by any teaching or suggestion in the art, but apparently is simply speculation on the part of the Examiner, it is respectfully submitted. Indeed, sealing in no other specific process or method or context is even mentioned.

Finally, the fact that the claims of Groups I and II may fall into different search categories is irrelevant when considering the requirement of restriction. As the Commissioner may from time to time reorganize the Art Groups, restrictions based upon this type of reasoning would allow the Commissioner to arbitrarily decide what is and is not subject to restriction. In other words, the division of art groups does not necessarily have anything to do with divisions of technology or inventions. When a particular art group gets to be too large, a logical area to divide the group is determined. This division does not necessarily define separate inventive areas, but is arbitrary. Using the Examiner's reasoning and the example above, a restriction could be required on one day because of

the separation of art groups that could not have been requested the day before. It is respectfully submitted that the passage of time and the arbitrary division of art groups should not enter into the restriction requirement. This is not the intent or the proper application of the restriction requirement. Reconsideration is respectfully requested.

It is respectfully submitted that the arguments and discussion presented above overcome the restriction requirement and place the claims in condition for allowance. Reconsideration of the restriction requirement, and consideration and allowance of the claims are respectfully requested. The Examiner is respectfully reminded of his duty to indicate allowable subject matter. The Examiner is also invited to call the Applicants' attorney at the number below for any reason, especially any reason that may help advance the prosecution.

Respectfully submitted,
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